



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Re. Appellant.: Kenneth R. LaBounty, et al
Serial No.: 09/524,904
Filed: March 14, 2000
For: HEAVY-DUTY DEMOLITION APPARATUS WITH
REPLACEABLE TIP AND ROTABLE CROSS BLADE
Examiner: William Hong
Group: 3725
Confirmation No.: 8475
Attorney: Gerald E. Helget
Attorney Docket No.: 33144.18
Additional Fees: Charge to Deposit Account 02-3732

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137 Reply Brief
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BOX AF
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

APPLICANT'S REPLY BRIEF

This Reply Brief is submitted under 37 CFR 1.193 to the Examiner's Answer mailed October 10, 2002.

CERTIFICATE OF MAILING

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By *[Signature]*
Date *9 Dec 02*

VIII. ARGUMENT

Claims 1-12, 14-17 and 19-20 under 35 U.S.C. 103(a) are not unpatentable over Sederberg in view of Ramun.

Applicant maintains that the Examiner has not established a *prima facie* case of obviousness. The Examiner bears the initial burden of presenting a *prima facie* case of obviousness.¹ If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned.² "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art."³

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.⁴ Second, there must be a reasonable expectation of success.⁵ Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations.⁶ The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.⁷

The Examiner has not established a *prima facie* case of obviousness because the prior art relied upon does not disclose, suggest, or render obvious the claimed invention, either individually or when combined⁸, because the references do not teach or disclose all claimed limitations.

As to claim 1, Sederberg does not teach an indexable, rotatable cross blade removably mounted to the inside of the tie plate substantially transverse to the lower shear blade and to the guide blade, the cross blade having four cutting surfaces for successive exposure and shearing. Clearly, the construction of Sederberg teaches away from a cross blade with four

¹ *In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

² *Id.*

³ *Id.*

⁴ Manual of Patent Examining Procedures, §2143

⁵ *Id.*

⁶ *Id.*

⁷ *Id.* (emphasis supplied)

⁸ *Rijckaert*, 28 USPQ2d at 1957

cutting surfaces that can be rotated for successive exposure and shearing. There would be, therefore, no motivation to combine the Ramun reference with Sederberg.

Claim 1 is therefore allowable.

Claims 2-11 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

Claim 12 is allowable for the reasons given above in relation to claim 1.

Claims 14-16 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

Appellant argues that claim 17 does not stand or fall together with the other claims of this group. Claim 17 is separately allowable because the references do not teach or suggest a cross blade forming a first angle between one and thirty degrees with the tie plate. Sederberg in fact teaches away from such a construction at col. 5 line 57 to col. 6 line 4, where it is stated that the outer end wall 32 and other components (which would include the cross blade 94) "extend in planes parallel to the reference plane defined by the proximal end shoulder 58." No other construction is disclosed. Since Sederberg requires the cross blade to be parallel to the end shoulder 58 and thus parallel to the tie plate, it teaches away from Applicant's claimed construction wherein the cross blade is positioned at an angle to the tie plate 54.

Claims 19-20 contain additional elements or limitations beyond allowable claim 17 and are therefore also allowable.

Response to Examiner's Answer

In his Response to Argument, the Examiner states:

"Although Sederberg does not explicitly disclose an "indexable" cross blade, Sederberg does disclose a cross blade (94) in figure 11 that can be rotated "to enable use of all four longitudinal edges thereof as the principal cutting edges." *Sederberg patent*, column 7, lines 65-67. Applicant's reference to a boss (98) is only one embodiment of the Sederberg invention. The alternative Sederberg embodiment illustrated in figure 11 clearly does not contain the boss (98) but rather a

bolting arrangement comparable to Appellant's apparatus illustrated in figure 1 of the instant application...."

Although figure 11 does not contain a boss, Applicant respectfully submits that one of ordinary skill in the art would recognize that the cross blade 94 is not indexable and rotatable with four cutting surfaces for successive exposure and shearing. The slot 92 of Sederberg is clearly designed to accept the rectangular cross blade 94 in only one orientation, i.e., as shown in Fig. 11. Rotation of the cross blade 94 to expose the two "short" sides (as shown in Applicant's Figure 4) would clearly be unworkable because the cross blade would protrude out of the slot 92 and break off as the upper jaw is closed on the lower jaw.

Therefore, although Sederberg states that all four edges of the cross blade can be used as the principal cutting edges, the embodiments of Sederberg do not allow successive exposure of four edges for shearing, as claimed by Applicant. In fact, examination of Figure 11 of Sederberg will clearly indicate that at any time two of the longitudinal edges are concurrently (not successively) exposed, and therefore two of these edges would wear concurrently.

Applicant defines "successive" exposure at page 6 of the Specification, as follows:

The cross blade 60 preferably has a plurality of cutting surfaces 62a, 62b (Fig. 4) and the cross blade is rotatably mounted to the tie plate 56 whereby each of the plurality of cutting surfaces 62 which may be successively exposed for shearing the workpiece, as shown by the arrows in Fig. 4. Most preferably, the cross blade 60 has four cutting surfaces 62a, 62b, 62c, 62d (Fig. 6).

In summary, the cross blade of Sederberg simply does not meet all limitations of the claims, as Applicant has already fully discussed. Even without the boss 98, there is therefore no motivation to combine the Ramun reference with Sederberg. In any case, none of the drawings of Ramun disclose the claimed limitation of four cutting surfaces successively exposed for shearing.

The Examiner also argues that, even though the references do not teach or suggest a cross blade forming a first angle between one and thirty degrees with the tie plate, that "when general conditions are disclosed, it has been held that it is not inventive to discover the optimum or workable ranges by routine experimentation when general conditions are disclosed in the prior art."

With due respect, the Examiner has missed the issue here. It is not a matter of "routine experimentation." Sederberg completely teaches away from the claimed limitation, as discussed above. Whether or not the claimed angles could be discovered by "routine

experimentation", claim 17 is not obvious because Sederberg not only does not disclose the limitation, but teaches away from it.

The Examiner also noted that the claims as written are not in condition for appeal.

As to claim 7, Applicant would be willing to accept cancellation by Board action or remand to the Examiner with an instruction to amend by Examiner's action.

Applicant submits that whether or not the Japanese reference was concisely explained on an Information Disclosure Statement has no bearing on this appeal.

Applicant is at a loss to understand the Examiner's objection to the drawings. The reference numeral "20" appears only in Figure 1 of the formal drawings submitted on January 23, 2002. The apparatus is clearly designated by reference numeral "10."

In view of the foregoing, Appellant asks the Board to overturn the Examiner's rejections and allow all claims.

Respectfully submitted,

Dated: 12/10/02

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TRANSMITTAL COVER LETTER

Enclosed for filing, please find the following:

1. Applicant's Reply Brief (5 pgs.); and
2. Postcard Receipt.

Respectfully submitted,

Dated: 9 Dec 2002

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